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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,550	02/23/2007	Hideji Tajima	10287.76	6278
27683 7590 01/29/2010 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER KILPATRICK, BRYAN T				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,550

Applicant(s)

TAJIMA ET AL.

Examiner

BRYAN T. KILPATRICK

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 and 21-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I - claim(s) 1-12 and 17-20, drawn to a sample arraying/assembling device with a distribution section and a method of distributing samples.

Group II - claim(s) 13-16 and 21-23, drawn to a sample arraying/assembling device with detachable components and a method of assembling components.

Group III - claim(s) 24, drawn to a wound body.

Group IV - claim(s) 25, drawn to a sample arraying/assembling device comprising an assembly body.

Group V - claim(s) 26, drawn to a sample arraying/assembling device having a translucent or semitranslucent pipette tip and an optical acquisition section.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I is a distribution section with a method of distributing samples claimed therein which is not present in Groups II-V. The other claimed special technical features are detachable components with a

method of assembly for Group II, a wound body for Group III, an assembly body for Group IV, and a translucent/semitranslucent pipette tip and an optical acquisition section for Group V.

Applicant's election of Group I, claims 1-12 and 17-20, in the reply filed on 29 October 2009 is acknowledged. **Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse** (MPEP § 818.03(a)).

Newly submitted claims 27-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: instant claims 27-28 cite a "rotating section" that is cited in the nonelected claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. **Accordingly, claims 27-28 are withdrawn from consideration as being directed to a non-elected invention.** See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 20 June 2009. It is noted, however, **that applicant has**

not filed a certified copy of the 2003-177228 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-12, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2001/0046699 (Tajima).

In regards to instant claims 1-4, Tajima discloses an invention for positioning substances for detection, a film for use in positioning substances for detection, and a manufacturing method for a carrier for substances for detection. The invention has a dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract). The invention discloses positioning dispensers (12 and 14 of Fig. 1) along XYZ axes such as in a matrix or array in paragraph [0080]. The invention discloses the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (paragraph [0047]), similarly to the wound body made of a string or thread-like member of instant claim 1 with a flat face or surface.

In regards to instant claims 6-7, Tajima discloses positioning dispensers (12 and 14, or 37 and 39 of Fig. 1). The dispensers have nozzles (13, or 36 and 38 of Fig. 1) for dispensing sample paragraphs [0079]-[0080] and [0091].

In regards to instant claim 8, Tajima discloses the use of a displacement device (Abstract).

In regards to instant claims 9-10, Tajima discloses the use of concave and convex sections in paragraph [0106].

In regards to instant claim 11, Tajima discloses the use of markings with a spiral produced from producing a spiral disk shaped carrier from a rolled film (paragraph [0047]).

In regards to instant claim 12, Tajima discloses a table (15 of Fig. 1) and a displacement device (paragraph [0080]).

In regards to instant claim 17, Tajima discloses an invention for positioning substances for detection, a film for use in positioning substances for detection, and a manufacturing method for a carrier for substances for detection. The invention has a dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract). The invention discloses positioning dispensers (12 and 14 of Fig. 1) along XYZ axes such as in a matrix or array in paragraph [0080]. The invention discloses the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (paragraph [0047]), similarly to the wound body made of a string or thread-like member of instant claim 1 with a flat face or surface. Tajima further discloses the use of an integrated core with film rolled around it in paragraph [0051].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0046699 (Tajima) as applied to claims 1-4 above.

Instant claim 5 is dependent on any one of previously rejected instant claims 1 through claim 3 above. Tajima discloses an invention for positioning substances for detection, a film for use in positioning substances for detection, and a manufacturing method for a carrier for substances for detection (Abstract). The invention has dispensers having at least one conduit for holding material and a suction/discharge device (Abstract), and employs the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (paragraph [0047]), similarly to the wound body of instant claim 1 with a flat face or surface.

Even though Tajima does not expressly disclose the use of a prism shaped wound body, it is well known in the art and the field of geometry of prism shapes having many edges that form a disk-like shape such as a decagonal prism. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the disk shaped rolled film of Tajima similarly as the prism wound body of the instant claims.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0046699 (Tajima), and in further view of U.S. Patent 5,895,631 (Tajima-2).

Instant claims 18-20 recite a method of distributing samples on a string or thread-like slender foundation member comprising a holding step and a contact step. Tajima

discloses an invention for positioning substances for detection, a film for use in positioning substances for detection, and a manufacturing method for a carrier for substances for detection. The invention has a dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract). The invention discloses positioning dispensers (12 and 14 of Fig. 1) along XYZ axes such as in a matrix or array in paragraph [0080]. The invention discloses the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (paragraph [0047]), similarly to the wound body made of a string or thread-like member of instant claim 1 with a flat face or surface.

Even though Tajima discloses a device capable of performing the method of the instant claims, Tajima does not expressly disclose a method comprising a holding step and a contact step. However, Tajima-2 discloses a liquid processing method for using a pipette device to pipette a substance from inside a vessel and transferring the substance to another liquid or target (Abstract of Tajima-2), which encompasses the holding and contact steps of the instant claims. Since the Abstract of Tajima discloses an apparatus that employs a suction/discharge device that is similar to the pipette device disclosed in the Abstract of Tajima-2, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the apparatus of Tajima to perform the method of Tajima-2 for the purpose of transferring a liquid from one location to another for the purpose of executing an analysis process such as detection (Abstract of Tajima-2, and paragraph [0142] of Tajima).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN T. KILPATRICK whose telephone number is (571)270-5553. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. T. K./
Examiner, Art Unit 1797

/Samuel P Siefke/
Primary Examiner, Art Unit 1797